

## REMARKS

Claims 1-5, 7, 9-11, 13, 15-17, 21-29 and 33-42 are pending in the present Application. Claims 21-32 and 41 have been canceled, Claim 1 has been amended, leaving Claims 1-5, 7, 9-11, 13, 15-17, 33-40 and 42 for further consideration upon entry of the present Amendment.

Claim 1 has been amended without prejudice, including Applicants' right to file the exact pre-amended claim in a continuation application. Claim 1 has been amended to include the limitation from Claim 41 in an effort to expedite allowance of this application. For the purposes of responding to the rejections below, reference will be made to Claim 1 in those rejections referencing Claim 41.

Claims 21-32 have been cancelled without prejudice, including Applicants' right to file the exact claims in a continuation application, to expedite allowance of this application or simplify issues for appeal.

Applicants respectfully request that these amendments be entered because they 1) do not raise new issues that would require further consideration and/or search; 2) they do not raise issue of new matter; and 3) no new claims have been added.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

### Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1-5, 7, 9-11, 13, 15 and 21-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486).

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486).

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486), and further in view of Babcock et al. (U.S. Patent No. 4,746,365).

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486), and further

in view of Babcock et al. (U.S. Patent No. 4,746,365) and Miyakoshi (U.S. Patent No. 5,827,788).

For Claims 21-29, the above rejection is moot as those claims have been canceled without prejudice.

For Claims 1-5, 7, 9-11, 13, 15, 16, 17, and 40, the rejections are moot as Claim 1 has been amended to contain the limitation of dependent Claim 41. The above-cited references either alone or in combination at least fail to teach or suggest that “the mineral pigment has a particle size such that at least about 95 percent by weight of the mineral pigment particles pass through a 100 mesh wire screen, with about 75 percent of the particles by number being greater than 5 microns.”

Claims 33, 35-39 and 41-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486) and further in view of Deodhar et al. (US 2002/0113572).

In making the rejection, the O.A. correctly states that “Randall et al. in view of Ali fail to teach that the pigment has a particle size such that at least about 95% by weight of the mineral pigment particles pass through a 100 mesh wire screen as required by claims 33 and 41”. (O.A. pages 8 to 9). Rather, the O.A. relies primarily upon paragraph [0025] of Deodhar et al. to remedy the deficiencies of Randall et al. and Ali.

Deodhar et al. is directed to coatings for paper facers. For example, Deodhar et al. teach that “the coating of the present invention may be used to replace the top, light colored plies of the face paper. Light color is provided by the coating, and, since the strength of the paper is provided by the plies of hard fibers, no strength is lost by removal of the top plies.” (Paragraph [0025]).

Randall et al. teach away from the use of paper facers for gypsum boards. (See generally paragraphs [0007] and [0008]). For example, Randall et al. teach “the paper facing is subject to biological degradation from mold and mildew. The paper can actually rot away.” (Paragraph [0007].) Additionally, Randall et al. teach that “to be an effective mineral pigment, the pigment should have a particle size such that a least about 95% percent of the pigment particles pass through a 325 mess wire screen.” (Paragraph [0042])

“It is difficult but necessary that the decision maker forget what he or she has taught...about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983); MPEP 2141.01 II.

If we are to cast our mind back to the time of the invention, as we are required to do, we will see that a *prima facie* case of obviousness has not been established, because in order to combine references, as suggested by the Office Action, a person of skill in the art would have to disregard Randall et al. teaching away of the use of paper and disregard their teaching of a certain pigment size in the coating when there is no suggestion in any of the references to ignore these teachings or any suggestion that ignoring these teachings will work with any reasonable expectation of success.

Since a *prima facie* case of obviousness has not been made, Applicants’ respectfully submit that independent Claims 33 and 41 (now Claim 1) are allowable for at least the reason that the prior art does not suggest with a reasonable expectation of success each and every claimed element. Moreover, as dependent claims from an allowable independent claim, Claims 35-39 and 42 are, by definition, also allowable.

Claim 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486) and Deodhar et al. (US 2003/0113572), and further in view of Kennedy et al. (US 5,484,653)

As noted above, the use of Deodhar et al. in combination with Randall et al. and Ali fail to establish a *prima facie* case of obviousness. Kennedy et al. fail to cure the deficiencies of Deodhar et al., Randall et al, and Ali. More particularly, Kennedy et al. is relied upon in the Office Action for teaching details about glass mats. However, Kennedy et al. does not teach the claimed limitation that the mineral pigment has a particle size such that at least about 95 percent by weight of the mineral pigment particles pass through a 100 mesh wire screen, with about 75 percent of the particles by number being greater than 5 microns. Rather, the Office Action had relied upon Deodhar et al. for teaching this element.

However, as noted above, Deodhar et al. cannot be combined with Randall et al.

without improper hindsight by for example, disregarding the size of mineral pigment taught by Randall et al. and replacing it with the mineral pigment from Deodhar et al. when there is no motivation or suggestion that the combination will work with any reasonable expectation of success. For at least this reason, independent Claim 33 is allowable. As such, Claim 34 is allowable for at least the reason that it depends from an allowable independent claim.

Double Patenting

Claims 1-5, 7, 9-11, 13-17 and 21 are provisionally rejected on ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-16, and 18-23 of copending Application No. 10/417,344 in view of Ali.

Claims 1-5, 7, 9-11, 13-17 and 21 are provisionally rejected on ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,808,793 in view of Ali.

These rejections are moot, since Claim 1 has been amended to include the limitation of Claim 41, which is not included in the above double patenting rejections. As such, Applicants respectfully request that these double patenting rejections be withdrawn.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fees be charged to Deposit Account No. 50-3313.

Respectfully submitted,

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